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10/812,360	03/30/2004	Katsunari Morishima	001309.00058	4113

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EXAMINER
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MITCHELL, KATHERINE W

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/812,360

Applicant(s)

MORISHIMA ET AL.

Examiner

Katherine W. Mitchell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 02 August 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 August 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/10/2005; 3/30/04</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the nut retaining apparatus 283 must be shown or the feature(s) canceled from the claim(s). "283" appears in Fig 6, but it is pointing to the nut. No new matter should be entered.
2. Fig 5 is incorrectly labeled. This is two Figures - they should be labeled "5A" and "5B", and not as Fig 5, "A" and "B".

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### **Specification**

3. The abstract of the disclosure is objected to because it claims purported merit of the invention. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

*The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.*

4. The disclosure is objected to because of the following informalities: Examiner cannot find where the nut retaining apparatus is described as distinct from the nut retainer.

Appropriate correction is required.

### **Claim Clarifications**

5. Applicant has positive recitation of the body in the independent claims, [is mounted on the body] thus examiner is considering the claims drawn to the COMBINATION nut retaining apparatus and body.

### **Claim Rejections - 35 USC § 112**

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 12,13,14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The only pipe member disclosed at all is lateral member 26 "second lateral frames 26, 26, 26, 26) which are lateral cross members (so-called pipe members)" which are shown in dotted line in Fig 1 and shown in Fig 3, but examiner cannot understand or see how they are in any way related to the nut retaining apparatus. Examiner is unable to examine these claims. It also appears that applicant may be trying to claim a method of using the device rather than the apparatus itself. Examiner also notes that the nut retaining device must describe the overall invention - if applicant is trying to claim an entire structure, it is not a nut retaining device.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claims 1 and 15 recite "... insert a bolt into an end surface of a body from a direction inclined with respect to a tangent direction to fasten the bolt ...". Tangent with

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respect to what? Everything is tangent with respect to at least some unnamed surface or object.

tan·gent (tăn'jənt) *adjective*

1. Making contact at a single point or along a line; touching but not intersecting. <sup>1</sup>

Applicant claims a nut retaining apparatus comprising a nut retainer. The nut retainer is described as "283", but the only figure (fig 6) with such a reference number has this pointing to the nut. "281" is described and shown as the nut holder. How does the nut retaining apparatus comprise the nut holder? How does the nut retaining apparatus differ from a nut retainer? "N" in Fig 6 is disclosed as the nut retaining apparatus, but as best examiner can tell, "N" includes the bolt, the body, the hole, etc. which is not possible since claim 1 requires the nut retaining apparatus to be distinct from the bolt, the body, and the hole.

Applicant also recites "an insertion end of the bolt insertion hole". How does one determine which end is an insertion end of the hole? Examiner assumes it becomes an insertion end if the nut hold is provided at that end, since the bolt would be inserted in the nut at that end.

Claims 5, 6, 19,20 -- the nut holder is mounted "from below". From below what? Further, there is no inherent "above" and "below" to a nut/body arrangement without structural details defining below or above.

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<sup>1</sup>Excerpted from *The American Heritage Dictionary of the English Language, Third Edition* Copyright © 1992 by Houghton Mifflin Company. Electronic version licensed from Lernout & Hauspie Speech Products N.V., further reproduction and distribution restricted in accordance with the Copyright Law of the United States. All rights reserved.

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Examiner cannot understand claim 14" "which constitutes furniture having a top is constituted".

Claims 2-14 and 16-21 are rejected as depending from claims 1 and 15 respectively.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-2,4-6,8-10,15-16,19-20 are rejected under 35 U.S.C. 102(a) as being anticipated by Schaaf USP 2820499.

Re claims 1 and 15: As best understood by examiner, (examiner is not sure of the difference in a nut retainer 283, nut retaining apparatus N, and a nut holder 281) Schaaf teaches a nut retaining apparatus mounted on a body (28) comprising a nut retainer (26) on an insertion end of the bolt insertion hole in the body, and against which the nut member (10) abuts, and a nut holder (25) that supports the nut and is mounted on the body, thereby retaining the nut member at a position of the nut retainer. The end surface of the body is inclined with respect to a tangent of something. Examiner notes applicant has not claimed direct mounting or connection, and it has been held that the recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

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The only structural limitations are a nut retainer provided on an insertion end of a body's hole, and a nut holder mounted on the body.

Further Re claim 15: The predetermined position is determined by the bolt bore - see Fig 4.

Re claim 2 and 8-10, 16, The nut holder has side support surfaces, and end surface support and engaging portion as described as shown in Fig 4 and 3.

Re claim 4: The end surface has a hole 38 in communication with threaded nut hole - see Fig 3 and 4.

Re claims 5-6 and 19-20: The nut holder is mounted to the body from below something. Further, since applicant is claiming the combination nut retaining apparatus and body, the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

13. Claims 1-6, 8-10, 15-16-20 are rejected under 35 U.S.C. 102(a) as being anticipated by Eaton USP 192620.

Re claims 1 and 15: As best understood by examiner, (examiner is not sure of the difference in a nut retainer 283, nut retaining apparatus N, and a nut holder 281) Eaton teaches a nut retaining apparatus mounted on a body (Fig 3) comprising a nut retainer (A) on an insertion end of the bolt insertion hole in the body (Fig 30, and against which the nut member (Fig 1 and 3) abuts, and a nut holder (B) that supports the nut and is mounted on the body, thereby retaining the nut member at a position of the nut retainer. The end surface of the body is inclined with respect to a tangent of something. Examiner notes applicant has not claimed direct mounting or connection, and it has



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been held that the recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). The only structural limitations are a nut retainer provided on an insertion end of a body's hole, and a nut holder mounted on the body.

Further Re claim 15: The predetermined position is determined by the bolt bore - see Fig 4.

Re claims 2 and 8,9,10,16: The nut holder/retainer (examiner is not sure of the difference in a nut retainer and a nut holder) B has side support surfaces (v-shaped groove Fig 1) and end surface support (flat surface of A which directly abuts the nut in Fig 1 and 3). The engaging portion is the side of A have spurs t.

Re claims 3,17: The side supports are vee shaped groove - see Fig 1.

Re claims 4 and 18: The end surface has a hole in communication with threaded nut hole - see Fig 3.

Re claims 5-6 and 19-20: The nut holder is mounted to the body from below something. Further, since applicant is claiming the combination nut retaining apparatus and body, the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

### ***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 7,11,21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schaaf USP 2820499.

Re claims 7,11,and 21: As discussed above, Schaaf teaches all the limitations except the material of construction as resin or aluminum. It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have selected resin or aluminum as the material of construction, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of engineering choice from known alternatives. *In re Leshin*, 125 USPQ 416. The method of forming the device (i.e., by die casting) is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

### ***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine W. Mitchell whose telephone number is 571-272-7069. The examiner can normally be reached on Mon - Thurs 10 AM - 8 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 571-272-7075. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Katherine W Mitchell  
Examiner  
Art Unit 3677

Kwm  
7/20/2005

A handwritten signature in black ink, appearing to read "Katherine W Mitchell", written in a cursive style.